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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,465	06/05/2001	David O'Hagan	P66645US0	5256

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,465

Applicant(s)

O'HAGAN, DAVID

Examiner

Maurie G. Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention from the following groups to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a process for the preparation of enantiomerically pure compounds of formula I.

Group II, claim(s) 9, drawn to a process for the preparation of enantiomerically pure polymer.

Group III, claim(s) 10, drawn to a process for the preparation of a library of enantiomerically pure compounds.

Group IV, claim(s) 11, drawn to an enantiomerically pure compound of the formula I (X is N and n is 1).

Group V, claim(s) 12, drawn to an enantiomerically pure polymer.

Group VI, claim(s) 13, drawn to a library of enantiomerically pure compounds

Group VII, claim(s) 14, drawn to pharmaceutical, veterinary product or agrochemical composition comprising an enantiomerically pure compound of formula I, Ii or Iii.

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3. The inventions listed as Groups I - VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

4. PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding "special technical features". It further defines "special technical feature" as "those technical features that define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art".

5. The technical feature that links the claims are the enantiomerically pure compounds of formula I. There are a myriad of compounds reading on those of formula I that are known in the art. See, for example, Sigma Catalog, page 195, (R)-(-)-sec-butylamine and (S)-(+)-sec-butylamine. These read on the compounds of the instant formula I when X is N; n is 1; R¹ is H; all instances of R² are H; Z is H; one instance of R³ is H and the other instance of R³ is C₁ alkyl (-CH₃). Thus, since the technical feature that links the claims is known in the art, the claims lack unity of invention.

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 (see paragraphs 15-16 below). The species are set forth as follows for each group with the generic claims also set forth.

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7. If applicant elects the invention of **Group I**, applicant is required to elect from the following species. Claim 1 is generic. Election of one species from each grouping below is required.

Species of reaction step

- A. Contacting with a source of hydrogen in the presence of a hydrogenation catalyst; e.g. claim 7
- B. Contacting with a source of fluorine as a fluorination agent; e.g. claim 8

Species of product and reactant

A *specific* product made and reactant used in the process should be elected where the compounds are completely defined (i.e. all atoms and bonds shown)

8. If applicant elects the invention of **Group II**, applicant is required to elect from the following species. Claim 9 is generic.

Species of product

A *specific* product made in the process should be elected where the polymer repeating unit (formula Ii) is completely defined (i.e. all atoms and bonds shown)

9. If applicant elects the invention of **Group III**, applicant is required to elect from the following species. Claim 10 is generic.

Species of reactant

A *specific* reactant (formula IV) used in the process should be elected where the compound is completely defined (i.e. all atoms and bonds shown). It is recognized that a library of compounds is made but the reactant used to make the library should be defined in as much as it represents the core of the library (structure all library members share)

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10. If applicant elects the invention of **Group IV**, applicant is required to elect from the following species. Claim 11 is generic.

Species of compound

A *specific* compound of formula I should be elected that is completely defined (i.e. all atoms and bonds shown)

11. If applicant elects the invention of **Group V**, applicant is required to elect from the following species. Claim 12 is generic.

Species of polymer

A *specific* polymer repeating unit of formula Ii should be elected that is completely defined (i.e. all atoms and bonds shown)

12. If applicant elects the invention of **Group VI**, applicant is required to elect from the following species. Claim 13 is generic.

Species of library

A *specific* library should be elected where the core of the library (structure all library members share) is fully defined

13. If applicant elects the invention of **Group VII**, applicant is required to elect from the following species. Claim 14 is generic.

Species of composition

A *specific* composition should be elected that is completely defined (i.e. compound of formula I, Ii or Iii having all atoms and bonds shown and all other constituents defined)

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14. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons.

15. As stated previously, PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". It further defines "special technical feature" as "those technical features that define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art". For example, unity of invention is fulfilled if:

- (a) all alternatives have a common property; **and**
- (b) (i) a common structure is present, i. e. a significant structural element is shared by all alternatives, or
- (b) (ii) in cases where the common structure can not be the unifying criterion, all alternatives belong to a recognized class of compounds in the art to which the invention pertains. (MPEP 1850).

16. In the instant case, part (a) above is not fulfilled because all claimed species do not have a recognized common property. Additionally, the compounds encompassed by the instant formulas do not all possess a common structure and do not belong to a recognized class of compounds in the art to which they pertain (i.e. widely varying structures encompassing many structural classes). There would be a significant search burden for searching all of the claimed species. Moreover, the claimed compounds of formula I are known in the art, see paragraphs 4-5 above. For these reasons, election under these rules is proper and required.

17. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

18. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

19. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

20. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
July 24, 2003



MAURIE GARCIA BAKER PH.D.
PRIMARY EXAMINER